

**REMARKS**

Claims 2-42 are currently pending.

**The Priority Claim**

The Patent Office states that the request for priority correction can not be handled by the Office of Initial Patent Examination, since PCT/US89/03593 was never given Rule 371 status in the parent application, and thus the PCT was never given national stage status. The Patent Office goes on to note that since US Patent No. 5,674,287 was a continuation and not a Rule 371 national stage application, the Applicants do not get the benefit of the earlier filed applications. The Examiner has also indicated that he is consulting with the Office of PCT for possible remedies.

Applicants are confused by this rejection, as it is believed that priority can be claimed to earlier filed applications under 35 U.S.C. §120, with reference to §363, if the application is “an international application designating the United States (35 U.S.C. §363), which is the case here with respect to PCT/US89/03593. Accordingly, it is believed that this rejection is improper.

**Rejections under 35 U.S.C. §102(e) in view of Spears**

Claims 2-9, 12-17, 28, 30, 32, and 37-42 have been rejected under 35 U.S.C. §102(e) as being anticipated by Spears, U.S. Patent No. 5,092,841 (“Spears”).

Spears is not be applicable as a reference under the proper priority claim of the instant invention. Thus, it is believed that this rejection is improper.

**Rejections under 35 U.S.C. §102(e) in view of Grubbs**

Claims 1, 5-8, and 40-42 have been rejected under 35 U.S.C. §102(e) as being anticipated by Grubbs, et al., U.S. Patent No. 4,919,151 (“Grubbs”). As claim 1 is not pending, it is believed that this is a typographical error, and that the Patent Office intended to reject claims 2, 5-8, and 40-42.

It is not seen where in Grubbs is there a disclosure or a suggestion of a pre-polymeric material that comprises at least one therapeutic agent. In Grubbs, a polymer is inserted through the cornea into the lens using a probe (column 2, lines 17-20). The polymer is provided for use

as an endocapsular lens replacement (column 1, lines 60-61). However, Grubbs does not disclose or suggest that the polymer can comprise at least one therapeutic agent.

Rejections under 35 U.S.C. §102(e) in view of Jones

Claims 1, 5-8, 10, 19, and 37-42 have been rejected under 35 U.S.C. §102(e) as being anticipated by Jones, U.S. Patent No. 4,978,391 (“Jones”). As claim 1 is no longer pending, it is believed that this is a typographical error, and that the Patent Office intended to reject claims 2, 5-8, 10, 19, and 37-42.

It is not seen where in Jones is there a disclosure or a suggestion of an initially entirely fluent, pre-polymeric material. In Jones, the prepolymer is described as being “soft” and “pliable” such that the prepolymer can easily be removed using standard dental cutting tools.” (see e.g., col. 2, lines 33-34).

Rejections under 35 U.S.C. §103(a) in view of Spears

Claims 10, 11, 18-27, 29, 31, and 33 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Spears.

As discussed above, Spears is believed to be inapplicable as a reference.

Rejections under 35 U.S.C. §103(a) with respect to Dunn in view of Jones or Grubbs

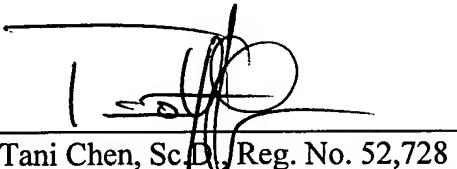
Claims 2-42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Dunn, et al., US Patent No. 4,938,763 (“Dunn”) in view of Jones or Grubbs.

Although Dunn is directed to certain polymers that can be used for biodegradable implants, Dunn nowhere discloses or suggests that such polymers can be polymerized using heat and/or radiation. To the contrary, the polymers in Dunn polymerize using certain catalysts, such as basic or neutral ester-interchange catalysts and/or metallic catalysts (col. 7, line 66 to col. 8, line 6). Since different polymerization reactions are involved, one of ordinary skill in the art, in combining Dunn with either Jones or Grubbs, would have no reasonable expectation of success in replacing the catalysts of Dunn with either heat and/or radiation, in causing the pre-polymeric material in Dunn to polymerize, in contrast to the Patent Office’s statements. Accordingly, it is believed that this rejection is improper.

**CONCLUSION**

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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